

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

In re Blue Water Wellness, LLC

Serial No. 87893655

Zachary Huey of Block45 Legal LLC
for Blue Water Wellness, LLC.

Lauren A. Dantzler, Trademark Examining Attorney, Law Office 122,
Michael Kazazian, Managing Attorney.

Before Cataldo, Adlin and Larkin, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Blue Water Wellness, LLC seeks registration of CBD2GO, in standard characters, for “dietary beverage supplements for human consumption in liquid and dry mix form for therapeutic purposes; all of the foregoing containing CBD.”¹ The term “CBD,” which appears in both Applicant’s mark and its identification of goods, refers to cannabidiol, an extract of the cannabis plant.²

¹ Application Serial No. 87893655, refiled December 20, 2018 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on an alleged bona fide intent to use the mark in commerce.

² As indicated, the involved application’s filing date is December 20, 2018, but Applicant originally filed the application on April 28, 2018. By way of explanation, the initial May 25, 2019 Office Action refused registration based, in part, on the federal Controlled Substances

The Examining Attorney finally refused registration pursuant to Sections 1 and 45 of the Trademark Act, 15 U.S.C. § 1051 and 1127, on the ground that Applicant did not have a bona fide intention to use the mark lawfully in commerce, because Applicant's CBD goods are illegal under the federal Food, Drug and Cosmetics Act ("FDCA"), 21 U.S.C. §§ 321(ff) and 331(ll). Thus, this case involves an application to register a mark for dietary supplements containing CBD which was refused because any use would be unlawful under the FDCA. This case is therefore on all fours with our recent precedential decision *In re Stanley Bros. Social Enter., LLC*, 2020 USPQ2d 10658 (TTAB 2020).

I. Evidentiary Objections

The Examining Attorney's objection to congressional testimony which Applicant submitted for the first time with its Appeal Brief, 6 TTABVUE 9-14, is sustained. Trademark Rule 2.142(d) ("The record in the application should be complete prior to the filing of an appeal.").

The Examining Attorney's objection to Applicant's claim in its Appeal Brief that it conducted a search of USPTO records which returned certain results, 6 TTABVUE

Act ("CSA"), 21 U.S.C. §§ 812(c) and 841(a)(1). Applicant argued substantively against this refusal, while simultaneously submitting, in the alternative, an amendment to the application's filing date pursuant to the USPTO's recent Examination Guide entitled "Examination of Marks for Cannabis and Cannabis-Related Goods and Services after Enactment of the 2018 Farm Bill" (Exam Guide 1-19). Under this Examination Guide, which reflects statutory changes in the 2018 Farm Bill, "applications filed on or after December 20, 2018 that identify goods encompassing cannabis or CBD" may now be entitled to register notwithstanding the CSA "if the goods are derived from 'hemp.'" Applicant's alternative amendment based on the Examination Guide was accepted, and the CSA refusal was withdrawn. December 26, 2019 Office Action TSDR 2.

7 n.2, is overruled, because the claim is not evidence, but instead merely attorney argument. At the same time, however, Applicant's mere claims, without evidentiary support, are not probative and have not been considered. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) ("Attorney argument is no substitute for evidence.") (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)); see also *In re U.S. Tsubaki, Inc.*, 109 USPQ2d 2002, 2006 (TTAB 2014) (finding that there was no proof to support the statements in the record by counsel).³

II. Evidence and Arguments

The Examining Attorney points out that under the FDCA, "the introduction or delivery for introduction into interstate commerce of a food to which has been added a drug or a biological product for which substantial clinical investigations have been instituted and for which the existence of such investigations has been made public," is illegal. 8 TTABVUE 6 (citing 21 U.S.C. §§ 321(ff) and 331(ll)). See also *In re Stanley Bros.*, 2020 USPQ2d 10658 at *13-16. She argues that while certain hemp/CBD products may no longer be subject to the CSA, they remain subject to the FDCA, relying on the statute itself and evidence from the Food and Drug Administration

³ During prosecution, Applicant mentioned a number of third-party registrations and provided their registration numbers. November 25, 2019 Office Action response TSDR 40. Applicant never introduced copies of the registrations, however, and therefore they have not been considered. See *In re Peace Love World Live, LLC*, 127 USPQ2d 1400, 1405 n.17 (TTAB 2018) ("[T]he list does not include enough information to be probative. The list includes only the serial number, registration number, mark, and status (live or dead) of the applications or registrations. Because the goods are not listed, we do not know whether the listed [applications or] registrations are relevant."); see also *Edom Labs, Inc. v. Licher*, 102 USPQ2d 1546, 1550 (TTAB 2012).

(“FDA”) concerning CBD. May 25, 2019 Office Action TSDR 13-27, 32-37; December 26, 2019 Office Action TSDR 5-19. In fact, substantial clinical investigations into CBD have not only begun, but the FDA has approved a drug containing CBD (Epidiolex). May 25, 2019 Office Action TSDR 9-12.

For its part, Applicant admits that its goods contain cannabidiol. November 25, 2019 Office Action response TSDR 42-43. It argues, however, that it is based in Florida, where “the sale of CBD food and dietary supplements is lawful under” Florida state law. 6 TTABVUE 3; June 26, 2020 Request for Reconsideration TSDR 7-14. Furthermore, while appearing to concede that federal law prohibits the sale of food products or dietary supplements which contain CBD, Applicant argues that “[g]iven the regulatory state of CBD and hemp under the 2018 Farm Bill, and the FDCA, this illegality will be resolved, and the Mark **will** be used with legal products.” 6 TTABVUE 4 (emphasis added).

In fact, Applicant relies on evidence which indicates that the legal status of foods and dietary supplements containing CBD is perhaps being reconsidered, and that it may change in the future. June 26, 2020 Request for Reconsideration TSDR 21-23 (H.R. 5587, 116th Cong. (2020)); *see also* December 26, 2019 Office Action TSDR 5-10, 19 (“The FDA is evaluating the regulatory frameworks that apply to certain cannabis-derived products that are intended for non-drug uses, including whether and/or how the FDA might consider updating its regulations, as well as whether potential legislation might be appropriate.”). Applicant specifically “requests the Board acknowledge the unique regulatory status of CBD and hemp,” which it refers to as

“regulatory flux,” and “create an exception to the usual rule regarding legality and a bona-fide intent to use.” 6 TTABVUE 5-6. Ultimately, Applicant “is planning for the inevitable future legality of CBD, and thus use of the Mark.” 6 TTABVUE 7.

III. Analysis

“[U]se of a mark in connection with unlawful shipments in interstate commerce is not use of a mark in commerce which the Patent [and Trademark] Office may recognize.” *Coahama Chem. Co., Inc. v. Smith*, 113 USPQ 413, 418 (Commr. Pat. 1957), *aff’d on other grounds*, 264 F.2d 916, 121 USPQ 215 (CCPA 1959). Accordingly, “[w]e have consistently held that, to qualify for a federal ... registration, the use of a mark in commerce must be ‘lawful.’” *In re PharmaCann, LLC*, 123 USPQ2d 1122, 1123 (TTAB 2017) (quoting *In re JJ206, LLC*, 120 USPQ 1568, 1569 (TTAB 2016) and *In re Brown*, 119 USPQ2d 1350, 1351 (TTAB 2016)).

The prohibition on registering marks for illegal goods applies to intent to use applications as well as use-based applications. That is, alleging an intent to use a mark for illegal goods is not the type of intent that would justify approving a mark for federal registration. *Id.* at 1124; *In re JJ206*, 120 USPQ2d at 1569 (“It logically follows that if the goods on which a mark is intended to be used are unlawful, there can be no bona fide intent to use the mark in lawful commerce.”); *John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d 1942, 1947-48 (TTAB 2010) (applicant “cannot lawfully use the mark” in its intent to use application as a result of an injunction, and therefore “it is a legal impossibility for applicant to have a *bona fide*

intent to use its mark in commerce”); Trademark Manual of Examining Procedure (“TMEP”) § 907 (2018).

Here, Applicant does not intend to use the mark in lawful commerce because its goods are food to which CBD has been added, and CBD has been subject to clinical investigations. Thus, the FDCA prohibits any sale of the identified goods. 21 U.S.C. § 331(ll); *In re Stanley Bros.*, 2020 USPQ2d 10658 at *11-13. *See also* 21 U.S.C. § 321(ff) (“a dietary supplement shall be deemed to be food within the meaning of this chapter”). As a result, Applicant’s stated intention to use the mark does not qualify as an intent to use the mark in lawful United States commerce.⁴

Neither “regulatory flux” nor the potential liberalization of the FDCA to, perhaps someday, allow for the sale of food or supplements containing CBD justifies a different result or any “exception” to how we treat marks such as Applicant’s. The United States Congress is constantly discussing, proposing and debating bills which would and someday could change laws. Sometimes, after vigorous analysis and debate, laws change; sometimes the status quo prevails. But it would be unworkable at best for the USPTO to change its own Rules or procedures in anticipation that certain proposed changes to federal law could someday be adopted.⁵

⁴ Florida law is not relevant here. *In re Brown*, 119 USPQ2d at 1351 (“Thus, the fact that the provision of a product or service may be lawful within a state is irrelevant to the question of federal registration when it is unlawful under federal law.”).

⁵ There are many administrative, fairness and other problems with Applicant’s suggestion, which can perhaps best be summed up by a quote widely attributed to Yogi Berra: “It’s tough to make predictions, especially about the future.”

In any event, the point is that “a bona fide intent to use the mark in commerce is a statutory requirement of a valid intent-to-use trademark application under Section 1(b)” of the Act. *M.Z. Berger & Co. v. Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892, 1898 (Fed. Cir. 2015). More specifically, the intent must be to use the mark in lawful commerce. *In re JJ206*, 120 USPQ2d at 1569; *John W. Carson Found. v. Toilets.com, Inc.*, 94 USPQ2d at 1947-48. Yet on the filing date of the involved application, the sale of the identified goods was illegal under the FDCA.

IV. Conclusion

Applicant did not have a bona fide intention to use its mark in lawful commerce on the filing date of its application because its identified goods were illegal under the FDCA, and remain so today.

Decision: The refusal to register Applicant’s proposed mark because the identified goods are illegal under the FDCA is affirmed.